APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/500,573	02/10/2000	Young-Soon Cho	0630-0982P	2817

7590   05/02/2005

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EXAMINER
HO, THOMAS M

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _06 November 2004_.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _27-48_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _27-48_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _10 February 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   The amendment of 11/06/04 has been received and entered.

2.   Claims 27-48 are pending. Claims 1-26 have been canceled.

Response to Arguments

3.   Applicant recites in paragraph 4 of page 8 of the arguments:

"Stefik shows a rather complex system for managing and controlling the distribution of digital

works between what Stefik calls "repositories."

The Examiner concurs that indeed Stefik discloses a rather complex system.

Applicant further argues on paragraph 4, page 10,

"The present invention, as recited in the pending claims, is directed to much simpler methods for

transferring a digital data file relative to a digital data player's memory. No generic ticket agent

and generic authorization server is required. Also, no ID certificate is involved with a digital

data player or the transfer of files to or from a digital data player. "

Indeed, as applicant has stated, the pending claims are directed to much simpler methods for

transferring a digital data file relative to a digital data player's memory. The Examiner would

contend, that is precisely why Applicant's pending claims must be examiner with the utmost

scrutiny to ensure that Applicant's claim directed to a simpler method can not be used to call into

infringement the systems of greater complexity, which may involve applicant's methods as a part

or subsystem of an invention of greater complexity.

Applicant argues on page 10, paragraphs 1-3:

The identification certificates 1306 are required to enable the use of the repository. (Emphasis

added)

Based upon the Stefik disclosure, it appears clear that one of ordinary skill in the art would

understand the Stefik system to require that any repository, downloading, copying or uploading a

digital work, must have an identification certificate. Such an ID certificate is very important to

the enablement of the Stefik system, in that Stefik states that it is "required by each and every

repository", and "must be updated on a periodic basis." In fact, Stefik states that without the ID

certificate, the system is not enabled"

Therefore, Stefik would not show or teach one of ordinary skill in the art how to transfer digital

data files between repositories having no ID code or ID certificate."

The Examiner contends that merely because other elements are disclosed in Stefik, but not in the

Applicant's disclosure, does not make the Stefik any less anticipatory.

Applicant's additional arguments have been fully considered but are moot in view of new

grounds of rejection.

Claim Objections

4.   For the purposes of expediting prosecution, the Examiner shall interpret

The last limitation of claim 1 to read as: "controlling whether or not the uploading of the digital

data is permitted to occur based..."

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 27-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al.

(Stefik) EP0715247A1.

Applicant's arguments have been carefully considered, but are moot in view of the new grounds

of rejection in light of Applicant's new claims.

As per claim 27:

Stefik et al. (Figure 1) discloses a method of transferring a digital data file comprising:

- Connecting a digital data player or a memory of the digital data player to a
  communications network via a first personal computer, where the digital data player is
  Repository 1, and where the first personal computer is the system from which the creator
  uploads his or her digital work. (Figure 1, Items 101, 102)

- Downloading a digital data file with an attached code segment from the communication
  network to the memory of the digital data player, where the digital data file is the digital
  work that the creator creates, and where the file is downloaded into the memory of the
  first repository and stored there.(Figure 1, Items 101, 102) & (page 3, lines 50-58)

- Connecting the digital data player or the memory of the digital data player to a second
  personal computer, different than the first personal computer, where the digital data
  player is the first repository, and the second personal computer is repository 2. (Figure 1,
  Items 103, 104 et seq.)

- Initiating an upload request to upload the digital data file from the memory of the digital
  data player to the second personal computer (Figure 1, Items 107, 108)

- Reading the code segment attached to the digital data file, where the code segment of the
  file is the usage rights. (Figure 1, Items 105)

- Controlling whether or not the uploading of the digital data file is permitted to occur
  based upon software interpreting the code segment. (Figure 1, Items 105-108)

While Stefik et al. fails to explicitly disclose the embodiment where repository 1 is a digital

player, it is understood that both repository 1 and repository 2 are computers with processors and

memory, running an operating system. (page 7, line 25 – page 8, line 25). It is well known in

the art that computers typically come equipped with them a basic player for digital media. For

Example, the ubiquitous Microsoft windows™ has packaged with it two programs called

notepad and wordpad, which allow the rendering or "playing" of text files. It also has a media

player which allows for the playing of digital music files, and internet explorer which allow

images to be viewed. Addtionally Stefik et al. discloses with it, a type of repository called a

"rendering repository" which allow for the digital works of Stefik et al. (music, video, images,

text) to be rendered or "played." (Figure 2), page 4(lines 15-20, and lines 40- 58) & page 5(lines

1-10)

Stefik et al. (page 4, lines 40-45) teaches "A rendering system is generally defined as a system

comprising a repository and a rendering device which can render a digital work into its desired

form"

It would have been obvious to one of ordinary skill in the art at the time of invention to have

repository 1 be a rendering system in order to allow it render the digital work into its desired

form.

As per claims 40-48:

Claims 40-48 recite a vending machine in place of a first personal computer and a personal

computer in place of a second personal computer but are otherwise substantially similar to claims

27-39. In claims 27-39, the Examiner has characterized the first personal computer as the

computer the creator of the digital work, and the second personal computer as repository 2. As

per claims 40-48, the Examiner shall characterize the computer of the creator of the digital work

as the vendor of the digital work, and his apparatus as the "vending machine". The personal

computer of these claims will be characterized as Repository 2.

As per claims 28-30, 32-35, 37-39, 41, 44, 46-48:

Stefik et al. discloses the method according to claim 27, wherein

- The software that reads the code segment and controls whether or not the uploading of

  the digital data player is permitted is resident in the digital data player, where the code

  segment is the usage rights, which is apart of the digital work. (page 6, lines 40-52)

- The software that reads the code segment and controls whether or not the uploading of

  the digital data file is permitted is resident in the digital data player and is uploaded from

  the digital data player to the second personal computer. (page 26, lines 5-30)

- The software that reads the code segment and controls whether or not the uploading of

  the digital data file is permitted is downloaded from the communication network to the

  memory of the digital data player along with the digital data file with the attached code.

  (page 26, lines 5-30)

- Wherein the software that reads the code segment and controls whether or not the

  uploading of the digital data file is permitted is resident in the second personal computer,

  where the software is present in repository 2. (page 8, lines 13-20)

- Wherein the memory of the digital data player is removable, where all RAM is inherently

  removable. (page 7, 40-54)

- Wherein the software permits the uploading of the digital data file to the second personal computer, and changes the code segment attached to the digital data file, where the software permits the uploading of the code and changes the copy count (page 20, lines 30-45)

- Wherein the code segment indicates a provider of the digital data file and is included in a header of the digital data file, where the provider is the owner. (page 6, table 1)

Stefik et al. fails to explicitly disclose the limitations:

- Wherein the digital data file is encoded using a compression coding technique prescribed in MPEG, layer 3.

- Wherein the digital data player is an MP3 player, and wherein the digital data file is a digital audio data file.

- Wherein the communication network is the Internet.

The Examiner takes official notice that MP3s, and the Internet were well known at the time of invention. It would have been obvious to one of ordinary skill in the art at the time of invention to encode files as Mp3s, and allow the data player to play them, as well as using the Internet as the communication network, in order to support digital music at a higher compression rate and allow the system of Stefik et al. to be open to Internet users, expanding its market.

As per claims 31:

Stefik et al. discloses the method according to claim 30, wherein the software is uploaded from

the digital data player to the second personal computer. (page 26, lines 5-30)

As per claims 36, 45:

Stefik et al. discloses the method according to claim 35 wherein the changed code segment

inhibits the digital data file from being uploaded to another computer at a later time. (page 21,

lines 30-40)

Examiners Comment

7.   US patent 6,577,735 claims a method for backing up data stored on a portable player that

is substantially similar to Applicant's invention and claimed limitations. Priority from this

invention extends to 2/12/99 as opposed to Applicants 2/10/99. Because of the rejection cited by

the Examiner in this action, consideration for possible Interference has not been pursued.

Conclusion

8.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of the final action and the advisory action is not mailed under after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension pursuant to 37 CFR

1.136(A) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this

final action.

9.   Any inquiry concerning this communication from the examiner should be directed to

Thomas M Ho whose telephone number is (571)272-3835. The examiner can normally be

reached on M-F from 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Gregory A. Morse can be reached on (571)272-3838.

The Examiner may also be reached through email through Thomas.Ho6@uspto.gov

Any inquiry of a general nature or relating to the status of this application or proceeding should

be directed to the receptionist whose telephone number is (571)272-2100.

| General Information/Receptionist | Telephone: 571-272-2100 | Fax: 703-872-9306 |
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TMH

April 17th, 2005

GREGORY MORSE
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